

The opinion in support of the decision being entered today
is *not* binding precedent of the Board

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KAZUNARI MOTOHASHI

Appeal 2007-1681
Application 10/613,371
Technology Center 1700

Decided: August 31, 2007

Before CHARLES F. WARREN, PETER F. KRATZ, and
CATHERINE Q. TIMM, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Applicants appeal to the Board from the decision of the Primary Examiner finally rejecting claims 1 through 3 in the Office Action mailed May 26, 2006 (Office Action). 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2006).

We remand the application to the Examiner for consideration and explanation of issues raised by the record. 37 C.F.R. §41.50(a)(1) (2007);

Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 5, August 2006).

The record shows that included in the grounds of rejection set forth in the Office Action was a ground of rejection of claim 2 under 35 U.S.C. § 112, first paragraph (Office Action 2-3).

Appellant did not request review of this ground of rejection or present argument with respect thereto (Br. 4; *cf.* 8, arguing a ground of rejection of claim 3 under 35 U.S.C. § 103(a) not set forth at 4).

The Examiner did not notify Appellant of this deficiency under 37 C.F.R. § 41.37(d) (2006). The Examiner states the “112 1st Paragraph rejection of claim 2” has “not been withdrawn by the examiner, but . . . [is] not under review on appeal because . . . [it has] not been presented for review in the appellant’s brief” (Answer 4). In responding to Appellants’ arguments with respect to the ground of rejection of claim 2 under 35 U.S.C. § 103(a), the Examiner states “Appellants have not addressed the interpretation given to claim 2, given the pending 112 1st Paragraph rejection on the subject matter of the claim,” and presumes Appellant agrees with the Examiner’s interpretation (*id.* 13-14).

37 C.F.R. § 41.37(c)(1)(vi) and (vii) (2005) provide that the Brief must set forth a “statement of each ground of rejection presented for review” and “[t]he contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section,” respectively. *See also* MPEP § 1205.02 (8th ed., Rev. 3, August 2005). Where Appellant does not present a ground of rejection for review in the Brief, the appeal is considered to be withdrawn with respect to that ground

and the “withdrawal is treated as an authorization to cancel the withdrawn claims.” MPEP §§ 1214.05 and 1215.03 (8th ed., Rev. 5, August 2006).

37 C.F.R. § 41.37(d) (2006) provides that Appellant will be notified of any deficiency in the Brief under the rules and provided with the opportunity to correct the deficiency. *See* MPEP § 1205.03 (8th ed., Rev. 5, August 2006).

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to notify Appellant of the deficiency in the Brief with respect to the ground of rejection under 35 U.S.C. § 112, first paragraph, and provide Appellant with the opportunity to cure the same in order to avoid withdrawal of the appeal and its consequences with respect to appealed claim 2, with a view toward placing this Application in condition for decision on appeal with respect to the issues presented.

This Remand is *not* made for the purpose of directing the Examiner to further consider the grounds of rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) (2007) does not apply.

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

REMANDED

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